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MAR 10 2005

OFFICE OF PETITIONS

In re Application of :
L. Wayne Sanderson, et al. :
Application No. 09/818,975 :
Filed: March 27, 2001 :
Attorney Docket No. 00-0564.56/US :
:

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 26, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (3).

A Restriction Requirement was mailed to applicant on November 18, 2003 that set a one-month shortened statutory period within which to submit a reply. Since no reply was received and no extensions of time under the provisions of 37 CFR 1.136 were obtained, the application became abandoned on December 19, 2003.

Petitioner has provided a five (5) month extension of time with the instant petition, suggesting that the date of abandonment is May 18, 2004. Nevertheless, an extension of time can only be obtained within six months from the mail date of the Office action at hand. Since the present extension was filed outside the six-month statutory period, it cannot be accepted and the date of abandonment is not extended. Petitioner may request a refund of the \$1005 extension of time fee by writing to the Office of Finance, Refund Section. A copy of this decision should accompany such a request.

With respect to item (3) noted above, petitioner has not met his burden of proof to establish to the satisfaction of the Commissioner that the entire delay in prosecution was herein unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b).

35 U.S.C. § 41(a)(7) applies to the situation of the above-identified application (*i.e.*, to the revival of an abandoned application), however, it precludes the Commissioner from reviving the above-identified application. The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Commissioner to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable."*[emphasis added]*. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The language of both 35 USC 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. However, as noted in more detail infra, both the delay herein in filing the reply during prosecution, and in filing the petition after abandonment, are inconsistent with a finding that the entire delay herein was unintentional, such that revival is warranted.

The showing of record is that the assignee deliberately withheld a reply to the Office action and intended that this application become abandoned. This application did become abandoned as a result of the assignee's deliberate intent. Thus, the assignee intended that no reply be filed and intended that prosecution be discontinued. This application became abandoned as a result of that deliberate intent.

An application abandoned by a deliberate decision not to continue prosecution of such application is not an "unintentionally abandoned application" within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See Application of G, 11 USPQ2d at 1380. The intentional abandonment of an application precludes revival under 37 CFR 1.137(a) or (b). In re Maldaque, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

While petitioner argues that there was no deliberate decision on his part not to continue prosecution of the above-identified application, this argument does not cause the assignee's intentional abandonment of the above-identified application to become an unintentional abandonment on petitioner's part:

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival. Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention (a submarine application) is the *par* softlineantithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to [37 CFR] 1.137.

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53132 at 53158-59 (October 10, 1997), reprinted at 1203 Off. Gaz. Pat. Office, 65 at 86 (October 21, 1997) (citations omitted).

Petitioner further argues that the word “applicant” refers to the inventor or joint inventors of the application. However, the applicants assigned their patent application rights to Verilink, Corp. who made the decision not to prosecute the application, resulting in its abandonment.

When the issue of revival is addressed, the focus must be on the rights of the parties as of the time of abandonment. See Kim v. Quigg, 781 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607 (E.D. Va 1989). Petitioner, as the assignor of his interest, could not demand that the assignee prosecute this case. An assignment of the entire right, title, and interest, passes both legal and equitable title. See, Wende v. Horine, 191 F. 620, 621 (C.C.N.D. Ill. 1911). Thus petitioner, as the assignor of his entire interest, could not insist that the application be prosecuted by the assignee, as the assignee was free to deal with the application it willed. See Garfield v. Western Electric Co., 298 F.659 (S.D.N.Y. 1924). As noted in MPEP 711.03(c), the question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. As the assignee intended that this application should become abandoned, the entire delay in prosecution during pendency and thereafter, results from an intentional action or inaction by the true party of interest. Further, petitioner, as the successor in title to the assignee is bound by any intentional delay arising from the assignee or his counsel, during the time the assignee was the owner. See Winkler v. Ladd, 221 F.Supp 550, 552, 138 USPQ 666, 668 (D.D.C. 1963); Kim v. Quigg, supra. That petitioner may have acted with dispatch after obtaining rights to this, then abandoned application is immaterial to, and does not overcome, the abandonment and resultant delay attributable to the assignee. Kim, supra; Winkler, supra.

If the rights of the assignee were terminated prior to or at the time the reply was due, petitioner should submit evidence of this termination, as well as an explanation as to why the applicants (by petitioner's definition) themselves, did not reply to the Restriction. However, if the rights of the assignee remained in effect during the aforementioned time, the application will continue to be abandoned.

If the assignee failed to perform any obligation of notification of its intent to abandon this application to petitioner, then petitioner's remedy with respect to the assignee would appear to lie under jurisprudence, and not by seeking the impermissible revival of an intentionally abandoned application before the USPTO.

Further correspondence with respect to this matter should be addressed as follows:

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By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is **(703) 872-9306**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223



Marianne E. Jenkins
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for Patent Examination Policy